



Paper No. 13

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COPY MAILED

MAY 31 2001

**OFFICE OF PETITIONS
A/C PATENTS**

ON PETITION

In re Application of
ITZEL et al.
Application No. 09/307,719
Filed: May 10, 1999 (CPA 4/10/01)
For: COOLING CIRCUIT FOR STEAM AND
AIR-COOLED TURBINE NOZZLE STAGES

This is a decision on the renewed petition under 37 CFR §§ 1.182 and 1.183, filed April 17, 2001 requesting extraordinary relief with respect to the requirements of 37 CFR 1.97 and 1.98 and also to suspend prosecution in all the applications listed in the accompanying appendix, which is being treated as a petition to waive the requirements of 37 CFR 1.98(a)(2) in any application containing a reference to the information disclosure statement submitted in above-identified application.

The petition is **GRANTED** to the extent indicated below.

It is noted that the timely CPA request of April 16, 2001, was not filed when the decision of March 22, 2001 was mailed. Petitioners may, of course, obtain the requested IDS consideration and determination of the "on sale" issues in the instant CPA without the need for extraordinary intervention in this application. The USPTO desires to accommodate petitioner's request *vis-a-vis* the other applications listed in the appendix to the petition to the extent that it is able

Subject to the conditions set forth below, the copy requirement of 37 CFR 1.98(a)(2) is hereby waived with regard to any IDS listing only information submitted in compliance with 37 CFR 1.97 and 1.98 in the above-identified application for any application containing a reference to the information disclosure statement (IDS) in the above-identified application. Petitioners must include a copy of this decision with the listing of information (37 CFR 1.98(a)(1)) submitted in any application invoking the waiver granted by this decision, as well as a copy of the forthcoming examiner's determination of the "on sale" issue.

If any application containing a reference to the IDS in the above-identified application becomes

open to public inspection (37 CFR 1.14), confidentiality under 35 U.S.C. § 122 for the above-identified application is considered waived and the above-identified application will also become open to public inspection. Any petition to expunge information in the IDS in the above-identified application must be filed and granted before the above-identified application, or any application containing a reference to the IDS in the above-identified application, becomes open to public inspection.

The waiver granted by this decision terminates on January 1, 2004. The Patent and Trademark Office may also terminate the waiver granted by this decision earlier than January 1, 2004 on notice to petitioners.

However, it is problematical, by way of a decision on petition in this application, to suspend the prosecution of all the applications listed in the appendix, as any statutory period that may be running in or against a given application must trump any possible relief that might be given under the rules of practice, which, of necessity, remain subservient to the statutes. Accordingly, the request for a blanket suspension of, or extraordinary relief with respect to, prosecution in all the applications listed in the appendix to the petition will not be granted. Likewise, as the rules of practice provide for submission of an IDS or other communication(s) in a given application, notwithstanding that prosecution may be closed therein, it is not necessary or advisable to waive the rules of practice to ensure inclusion and consideration of the forthcoming submissions related to the issues herein in all the applications listed in the appendix to the petition. Accordingly, the blanket request for waiver or other extraordinary remedy with respect to the timing requirements of 37 CFR 1.97 will not be granted. Petitioner is advised that the USPTO will not consider an extraordinary remedy for a given situation, where the rules of practice already afford an avenue for the relief requested. Nevertheless, while the above-noted blanket reliefs are not being favorably entertained by this decision in this application, the USPTO will consider, on a case-by-case basis, a request for extraordinary relief, that would assist petitioner in effectuating this decision with respect to any specific application listed in the appendix.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-1820.

The application file is being returned to Technology Center AU 3745 for further processing.



Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

July 25, 2001

Serial No. 09/307,719

In re Application of
ITZEL et al.
Serial No. 09/307,719
Filed: May 10, 1999
For: COOLING CIRCUIT FOR STEAM AND
AIR-COOLED TURBINE NOZZLE STAGE

RESPONSE
TO IDS

This is a determination of the "on sale" bar issue pursuant to Applicants' information disclosure statement (IDS) filed February 7, 2001 which included a request for decision on the relevance of submissions in the IDS to an "on-sale" bar. The individual submissions in that IDS have been listed in "Attachment A" to this letter. A listing of the applications affected by this determination have been listed in "Attachment B" to this letter.

SUMMARY OF RECENT DECISION ON PETITION

Before the determination is discussed, a summary of a PTO decision dated May 31, 2001 on Applicants' renewed petition dated April 17, 2001 is believed helpful to those examiners and practitioners who will be working on applications affected by this determination. A Senior Petitions Examiner in the USPTO Office of Petitions made the following decisions.

The copy requirement of 37 CFR 1.98(a)(2) was waived with regard to any IDS listing only information submitted in compliance with 37 CFR 1.97 and 1.98 in the above-identified application.

A copy of the May 31, 2001 decision on petition including the listing of information (37 CFR 1.98(a)(1)) must be submitted in any application invoking the copy requirement waiver.

A copy of the examiner's determination of the "on-sale" issue (this paper) must be submitted in any application invoking the copy requirement waiver.

If any application containing a reference to the IDS in the above-identified application becomes open to public inspection (37 CFR 1.14), confidentiality under 35 U.S.C. § 122 for the above-identified application is considered waived.

The waiver granted by the decision terminates on January 1, 2004 (or earlier if the USPTO sends notice to petitioners).

Petitioners' request for a blanket suspension of, or extraordinary relief with respect to, prosecution in all the applications listed in the appendix to the petition was not granted.

Petitioners' blanket request for waiver or other extraordinary remedy with respect to the timing requirements of 37 CFR 1.97 was not granted.

DETERMINATION OF IDS AND "ON-SALE" BAR

Applicants' submission of the present IDS was apparently precipitated by the recent Supreme Court decision in *Pfaff v. Wells Electronics, Inc.*, 119 S. Ct. 304 (1998) and other legal precedents as presented in the IDS. The Court in *Pfaff* held that an "on-sale" bar under 35 U.S.C. § 102(b) requires that two conditions must be satisfied before the critical date. First, the product must be the subject of a commercial offer for sale. Second, the invention must be ready for patenting.

As Applicants have noted, a threshold fact is necessary for the first of the two "on-sale" bar conditions to be considered; the activity which is being considered for the bar had to have occurred "in this country" as explicitly required by the statute.

Evaluating the submissions in the IDS filed February 7, 2001 against the backdrop of the case law for "on-sale" bar and the statute, there is no "on-sale" bar under 35 U.S.C. § 102(b). The submissions contain no description of any activity that could satisfy the threshold requirement for "on-sale" activity having occurred "in this country." Since the determination is predicated on the fact that the threshold requirement cannot be met, any analysis of the IDS with respect to the conditions stated by the Court in *Pfaff* is moot.

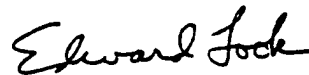
Furthermore, this determination is applicable to all of the applications listed in Attachment B. The issue of "on-sale" bar, particularly as it has been determined based on whether the threshold fact that any "on-sale" activity occurred "in this country" has been met, is not specific or unique to any one application but is common to all of the applications. Thus, this determination of the IDS applies to all applications listed in Attachment B.

In order to provide accessibility to the IDS for all patent examiners affected by the waiver of the copy requirement of 37 CFR 1.98(a)(2), a duplicate copy of the IDS will be retained in the office of SPE Edward Look (PK1-05F04; ph. 308-1044). Furthermore, a copy of the PTO decision dated May 31, 2001 on Applicants' renewed petition dated April 17, 2001 and a copy of this determination will also be retained in the same location.

The signatures of the Supervisory Patent Examiners (SPEs) who have the majority of the applications that are listed in Attachment B in their art units have been added to this determination. Each SPE has been briefed on the merits of this determination and each has concurred therewith.

CONCLUSION

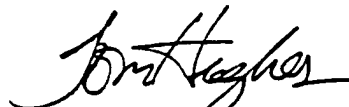
There is no "on-sale" bar under 35 U.S.C. § 102(b) based on the IDS submissions which consisted of declarations from current and former employees of General Electric International, Inc. (GEI) and General Electric Power Systems (GEPS) and their attached exhibits.



Edward Look
SPE, Art Unit 3745



Timothy Thorpe
SPE, Art Unit 3746



Thomas Hughes
SPE, Art Unit 3726

IDS Submissions Relating to "On-Sale" Consideration.

Declaration of David G. Wallace, Retired, Former Vice President and Director of General Electric International, Inc. (GEII). Dated December 20, 2000. (3 pages)

Exhibit I: Letter dated October 27, 1995 from David Wallace to John Azzizzi indicating that the 9H project for the K2 site "should be recorded." (1 page)

Declaration of Delbert Williamson, President, Global Sales for GE Power Systems (GEPS). Dated December 22, 2000. (6 pages)

Exhibit I: Letter dated March 16, 1998 from Delbert Williamson to Mr. Akira Arai. Proposal to TEPCO relating to a potential installation of an H system in Japan. (2 pages)

Exhibit II: Revised letter dated March 30, 1998. (2 pages)

Exhibit III: Letter dated April 17, 1998 from TEPCO to David Wallace. (1 page)

Declaration of Stephen Penfold, employee of GEII, was Sales Manager serving GEPS offices in London and Slough, U.K. Dated January 2, 2001. (7 pages)

Exhibit I: Formal technical proposal titled "GE Power Systems/Turbotecnica equipment and Services Technical Submittal for One (1) Stag 109H 50 Hertz Combustion Gas Turbine Power Plant for ENEL Porto Corsini, Proposal No. IPS-51252" dated February 1996. (8 pages)

Exhibit II: Memorandum of Understanding (MOU) dated March 27, 1996 between ENEL and a consortium to be formed by GEPS and TT (GE/TT consortium). (5 pages)

Exhibit III: Letter dated June 12, 1996 from Stephen Penfold to ENEL presenting the consortium's offering for further development, installation and testing of 9H gas turbine technology at the Porto Corsini site. (4 pages)

Exhibit IV: Letter (redacted) dated October 28, 1996 from Stephen Penfold to ENEL amending the consortium's prior offering concerning the development, installation and testing of the 9H gas turbine technology at the Porto Corsini site. (6 pages)

Exhibit V: Letter dated November 20, 1997 from Mr. William Jayne (GEPS) to Mr. Nanotti (ENEL) terminating the ongoing negotiations. (1 page)

Declaration of Alyson Clark, employee of GEIL, was regional legal counsel for GEPS in Europe. Dated January 31, 2001. (5 pages)

Exhibit I: Memorandum of Understanding (MOU) dated March 27, 1996 between ENEL and a consortium formed by GEPS and TT. (5 pages)

Exhibit II: Letter dated June 12, 1996 forwarded by Stephen Penfold to ENEL presenting GE/TT consortium's proposal for further developing, installing and testing 9H gas turbine technology at the site. (4 pages)

Exhibit III: Letter (redacted) dated October 28, 1996 forwarded by Stephen Penfold to ENEL amending the GE/TT consortium's proposal for further developing, installing and testing 9H gas turbine technology at the site. (6 pages)

Exhibit IV: Letter dated November 20, 1997 from Mr. William Jayne (GEPS) to Mr. Nanotti (ENEL) terminating ongoing negotiations. (1 page)

Declaration of Gerald Cullen, Commercial Leader for GEPS. Dated December 21, 2000. (7 pages)

Exhibit I: Minutes and attachments to the Minutes of a meeting in TEPCO's offices in Tokyo on February 23 and 24, 1994 to commence an initial feasibility study in connection with GEPS's advanced 9H gas turbine technology. (42 pages)

Exhibit II: GEPS design study proposal in March 1995. (41 pages)

Exhibit III: September 1996 "Summary Review of the TEPCO Advanced Machine" presented to TEPCO in Tokyo, Japan. (25 pages)

Exhibit IV: A further agreement dated January 3, 1997 between GEPS and TEPCO, effective December 4, 1996, relating to a detailed plan preliminary design study. (3 pages)

Exhibit V: Letter dated March 16, 1998 from Delbert Williamson to Mr. Akira Arai. Proposal to TEPCO relating to a potential installation of an H system in Japan. (2 pages)

Exhibit VI: Revised letter dated March 30, 1998 from Delbert Williamson to Mr. Akira Arai. (2 pages)

	<u>Atty. Dkt. No.</u>	<u>Serial No.</u>	<u>Filing Date</u>	<u>Group</u>	<u>Parent case</u>
1	839-473	09/021,081	2/10/98	3746	
2	839-558	09/292,445	4/15/01	3746	
3	839-561	09/334,187	6/16/99	3745	
4	839-563	09/511,552	2/23/00	2859	
5	839-564	09/384,198	8/27/99	3745	
6	839-566	09/307,719	5/10/99	3745	
7	839-583	09/332,330	6/14/99	3745	
8	839-588	09/340,510	7/1/99	3746	
9	839-595	09/494,244	1/31/00	2857	
10	839-605	09/285,499	4/1/99	3745	
11	839-607	09/286,151	4/5/99	3745	
12	839-617	09/385,572	8/30/99	2855	
13	839-623	09/496,715	2/2/00	3745	
14	839-631	09/488,033	1/20/00	2857	
15	839-642	09/372,190	8/11/99	3745	
16	839-645	09/354,336	7/16/99	3745	
17	839-659	09/395,619	9/14/99	2859	
18	839-673	09/491,599	1/25/00	3746	
19	839-674	09/404,589	9/24/99	3745	
20	839-676	09/482,361	1/13/00	3745	
21	839-682	09/400,863	9/21/99	3746	
22	839-685	09/533,195	3/23/00	3745	
23	839-688	09/520,459	3/8/00	3745	
24	839-706	09/557,541	4/25/00	3745	
25	839-713	09/571,813	5/16/00	3745	
26	839-714	09/571,835	5/16/00	3745	
27	839-715	09/561,865	4/28/00	3745	
28	839-716	09/547,933	4/11/00	3726	
29	839-717	09/586,043	6/2/00	3746	
30	839-718	60/185,696	2/29/00	unassigned	
31	839-720	09/544,102	4/6/00	3746	
32	839-721	09/552,687	4/19/00	3746	
33	839-730	09/571,814	5/16/00	3745	
34	839-735	09/567,296	5/8/00	3745	
35	839-736	09/585,840	6/1/00	3745	
36	839-745	09/513,070	2/25/00	3746	
37	839-746	09/731,907	12/8/00	3745	
38	839-748	09/489,672	1/24/00	3726	
39	839-753	09/638,072	8/11/00	1725	
40	839-755	09/533,194	3/23/00	3746	

	<u>Atty. Dkt. No.</u>	<u>Serial No.</u>	<u>Filing Date</u>	<u>Group</u>	<u>Parent case</u>
41	839-757	09/606,938	6/29/00	3752	
42	839-759	09/737,089	12/14/00	1722	
43	839-766	09/635,086	8/8/00	3746	
44	839-775	09/593,276	6/13/00	3745	
45	839-780	09/652,176	8/31/00	3746	
46	839-788	09/662,780	9/15/00	3745	
47	839-790	09/566,726	5/9/00	3745	
48	839-791	09/566,085	5/9/00	3745	
49	839-796	09/659,687	9/11/00	3746	
50	839-800	09/621,876	7/21/00	3746	
51	839-801	09/576,066	5/22/00	3745	
52	839-843	09/617,508	7/14/00	3745	
53	839-845	09/618,800	7/18/00	3745	
54	839-849	09/707,912	11/8/00	3629	
55	839-853	09/640,667	8/18/00	3746	
56	839-862	09/675,655	9/29/00	2856	
57	839-863	09/669,574	9/26/00	2856	
58	839-880	09/665,690	9/20/00	3745	
59	839-881	09/666,611	9/20/00	3745	
60	839-928	09/694,756	10/24/00	3745	
61	839-947	09/726,213	11/28/00	3745	
62	839-948	09/726,214	11/28/00	3746	
63	839-949	09/731,982	12/8/00	3745	
64	839-964	09/741,767	12/21/00	1725	
65	839-966	09/741,906	12/22/00	3745	
66	839-980	09/754,242	1/5/01	3745	
67	839-986	09/761,635	1/18/01	3745	
68	839-990	09/768,220	1/24/01	3745	09/404,589
69	839-992	09/769,749	1/26/01	unassigned	09/368,458
70	839-997	09/773,369	2/1/01	3746	09/292,445
71	839-998	09/777,998	2/7/01	3745	09/236,714
72	839-999	09/778,033	2/7/01	3745	09/354,336
73	839-1000	09/778,042	2/7/01	unassigned	
Serial Nos. 09/332,330 and 09/404,589 were not listed on Applicants' "Revised Appendix I to the Combined Petition and Information Disclosure Statement" filed March 2, 2001.					
However, they have been added to the list since they are believed to be affected by this determination of the IDS.					